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10/785,526	02/23/2004	Richard E. Rowe	IGTIP042C1/P- 392 DIV CON	1568
79646                      7590                      12/11/2008 Weaver Austin Villeneuve & Sampson LLP - IGT Attn: IGT P.O. Box 70250 Oakland, CA 94612-0250				
EXAMINER				
SAGER, MARK ALAN				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/785,526

**Applicant(s)**

ROWE, RICHARD E.

**Examiner**

M. Sager

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on see IDS listing cited below.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-854)  
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :3/12/04, 3/29/04, 7/19/04, 4/18/05, 9/15/05, 9/28/05, 10/11/05, 6/19/06, 5/1/08, 8/5/08.

***Priority***

1. The priority status of pending application appears to be a CIP to each of 10659827 and 09746944 due to Application Data Sheet (ADS) filed 3/29/05 stating that present application is a CIP to each 10659827 and 09746944. However, it is noted that paragraph 1 on page 1 of specification fails to specify whether present application is a CON or CIP but the PG-Pub face page appears to indicate present application is a CON to each of aforementioned apps, while transmittal letter suggests present application is a CON to each 10659827 and 09746944; however, transmittal letter is not a proper form for presenting a claim of priority benefit. MPEP 201.11. Thus, in this instance, it appears as filed that the present application is a CIP of each 10659827 and 09746944 due to the ADS submission. Applicant is requested to clarify status of present application with respect to at least '827 and '944 due to the difference in status of CIP and CON and accordingly amend appropriate documents (ADS, spec pg 1 para 1, and/or OATH/dec).

***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6645077 and over claims 1-36 of U.S. Patent No. 7186181. Although the conflicting claims are not identical, they are not patentably distinct from each other because Rowe '077 claims a network interface, memory and processor claimed herein; while, '181 claims a server that implicitly includes a network interface, memory and processor for transferring software to gaming terminals as claimed. Applicants admitted prior art is also noted as evidence shown below incorporated herein.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 8-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 8 recites the limitation "the promotion" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Interpretation***

6. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found

to be inherent in the prior art reference); see also *In re Swinchart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). MPEP 2114. Also, claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are: (A) “adapted to” or “adapted for” clauses; (B) “wherein” clauses; and (C) “whereby” clauses. The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “whereby” clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.” *Id.* However, the court noted (quoting *Minton v. Nat ’l Ass ’n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a “whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.” *Id.* MPEP 2111.04. In this case, the ‘wherein’ clauses are end result or environment of use that fail to patentably distinguish such that the clauses do not state a condition that is material to patentability. Also, the aforementioned ‘wherein’ clauses fail to further structurally define the claimed machine as a repository (i.e. server/database) and gaming system, since the clauses appear to relate to function.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 3, 5-8, 12-17 and 20-22 are rejected under 35 U.S.C. 102(a) as being anticipated by disclosed admitted prior art. Instant application presents admitted prior art as a server and system known or used by others that includes a network interface for communicating with gaming terminals (para 3-12, fig. 1), a memory to store gaming transaction information received from the plurality of gaming terminals (para 3-12, fig. 1) and, game software components for use by the plurality of gaming terminals (para 3-12, fig. 1), a processor to download to the gaming terminals game software components that comply with rules of gaming jurisdiction in which the gaming terminals are located (para 3-12, fig. 1), to download particular game software to a gaming terminal when the particular game software is requested (implicit for dumb gaming terminals; as further evidence per MPEP 2144.03 or 2131.01, see Boushy 5761647 @ abstract, 2:5-3:30 regarding dumb terminals so as to require download of selected game to slot game), wherein the game software components include game system components (abstract, para 3-12 fig. 1), to identify a user playing a game of chance at a gaming terminal (para 5, player tracking), to group a portion of the plurality of gaming terminals for generating a progressive game on the portion of gaming terminals and downloading software allowing a progressive game

to be generated on the plurality of gaming terminals (para 5, 7-8, fig 1; implicit for linked progressive game; as further evidence under 2144.03 and 2131.01 of linked progressive game terminals see Torango 5885158 or Kelly 5816918 or Xidos 5851149), to download game software for allowing a promotion [as a bonus] to be generated on the plurality of gaming terminals wherein a portion of the gaming terminals used in the promotion are owned by first gaming entity and wherein a second portion of the gaming terminals used in the promotion are owned by a second gaming entity (para 5-8, fig 1; as further evidence under 2144.03 and 2131.01 of linking terminals for promotion/bonus see Acres 5655961 or Boushy 5761647 or Eggleston 6061660 or Kelly 5816918 or Xidos 5851149), wherein the processor is further designed or configured to display performance data for each of a plurality of different game software configurations used on the gaming terminals (para 8-11, fig. 1), wherein the network interface is for communicating with a plurality of remote servers and the processor is designed and configured to communicate with the remote servers to gather information for storage in the memory regarding the plurality of gaming terminals (para 5, fig 1), to download player tracking software (para 5, 8, fig 1), download pay tables (para 5, 7-8, fig 1 for implementing progressive or bonusing; as further evidence under 2144.03 and 2131.01 for updating/modifying pay table for a bonus or progressive game see Torango 5855158 or Kelly 5816918 or Xidos 581149 or Acres 5655961 or Boushy 5761647 or Eggleston 6061660), download a device driver (para 5-8, fig 1, implicit due to gaming terminals including a computer or processor with associated drivers for network interface, display, graphics, sound, etc that require updating to utilize new features or protections/security), allows a bonus game to be generated (para 5, 7-8, fig 1), wherein the software components include game system components, gaming pay tables, bonusing,



progressives, graphics, sounds, and networking (sic), games of chance include slot machines and video poker (para 3-12, fig 1, supra). The disclosed bonus (para 3, 5, 7-8, fig 1) is deemed to relate to incentives, promotions, bonuses and secondary games as in evidence above.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over disclosure of admitted prior art in view of either O'Conner (6178510) or Paravia (6508710) or Martin (5618232). It is not clear whether the disclosed admitted prior art server and gaming system includes to determine the gaming jurisdiction where a particular gaming terminal is located. Determining a location of a gaming terminal is known as taught by either O'Conner or Paravia or Martin so as to comply with local jurisdiction gaming laws/requirements. Thus, it would have been obvious to an artisan at a time to apply the process to determine the gaming jurisdiction where a particular gaming terminal is located as taught by either O'Conner, Paravia or Martin to

improve the server and gaming system of the disclosed admitted prior art for the predictable result of complying with local jurisdiction gaming laws.

12. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art in view of Walker (6110041). The disclosed admitted prior art includes to determine the identity of a user at least with respect for player tracking (para 3, 5, 7-8, fig 1) but it is not clear whether the disclosed admitted prior art server and gaming system includes to determine a custom software configuration for the user and download the custom configuration for the gaming terminal. However, Walker discloses a method and system for adapting gaming terminals to user preferences (abstract, 2:13-49, figs 1-11b) so as to determine a custom software configuration for the user and download the custom configuration for the gaming terminal. Thus, it would have been obvious to an artisan at a time prior to the invention to apply the process to determine a custom software configuration for the user and download the custom configuration for the gaming terminal as taught by Walker to improve the server and system of the disclosed admitted prior art for the predictable result of adapting a terminal to user preferences including language, sound, pay table, game, bonuses, etc.

13. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art in view of Wain (4335809). Although, the disclosed admitted prior art includes to download game software for allowing promotions as a bonus including bonuses over multiple gaming sites that are owned by different entities such as different casinos (supra) but it is not clear whether the disclosed admitted prior art server and gaming system includes to download game software for a new game to a gaming terminal when a gaming performance of a current game on the gaming terminal is assessed as poor. Wain discloses a server linked to gaming terminals where

the program information of the or each machine may be varied to change or modify the game played therewith in the event that signals from the machine indicate that the machine is not being frequently used so as to entice players to use the gaming terminal. This is consistent with aforementioned bonus above. However, it is likewise known as a business model for an owner to replace or add new games to entice players to use a gaming terminal. Thus, it would have been obvious to an artisan at a time prior to the invention to apply the process of to download game software for a new game to a gaming terminal when a gaming performance of a current game on the gaming terminal is assessed as poor as known business model as suggested by Wain to improve the server and system of disclosed admitted prior art for the predictable result of encouraging players to continue using a gaming terminal so as to increase revenues.

14. Claims 10-11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over disclosed admitted prior art in view of Alderson (5019963), Fawcett (5845077), Frye (6047129) or Halliwell (5473772). Although the disclosed admitted prior art server and system includes to store to the memory game software transaction information (para 3, 5, 7-12), it is not clear whether the disclosed admitted prior art server and gaming system includes to store to memory current and past gaming software configurations for each of the plurality of gaming terminals (clm 10) and to receive game component information from the gaming terminals wherein the component information describes the game software components on the gaming terminals (clm 19). Regarding claim 10, configuration control of a machine or system is known so as that a user is aware of configuration of the version of components used in its manufacture/build for licensing, repair and maintenance. In particular, the configuration of a gaming machine is required to be maintained for compliance with local jurisdiction laws. Thus, either the admitted

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prior art server and system implicitly includes configuration control such as to store to memory current and past gaming software configurations for each of the plurality of gaming terminals so as to comply with local jurisdiction laws or it would have been obvious to an artisan at a time prior to the invention to apply the process store to memory current and past gaming software configurations for each of the plurality of gaming terminals as known for compliance to improve the server and gaming system of disclosed admitted prior art for the predictable result of maintaining an auditable history of gaming terminal form/structure and software so as to comply with local laws. Further, regarding claim 19, Alderson (abstract), Fawcett (abstract), Frye (abstract) or Halliwell (abstract) disclose software updating via a server based on list of software stored on terminal being communicated from terminal to server to check for which software is out of date and needs to be updated so as to teach/suggest to receive game software component information from the gaming terminals wherein the game software component information describes the game software components store on the gaming terminals. Thus, it would have been obvious to an artisan at a time prior to the invention to apply the process to receive game software component information from the gaming terminals wherein the game software component information describes the game software components store on the gaming terminals as taught/suggested by Alderson, Fawcett, Frye or Halliwell to improve the server and gaming system of disclosed admitted prior art for the predictable result of automatically updating out of date software components.

15. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over disclosed admitted prior art in view of Heath (6006034). Although the disclosed admitted prior art server and system includes updating game software components (para 3, 5, 7-12), it is not clear whether

the disclosed admitted prior art server and gaming system includes to update game software components on gaming terminals using one or more update triggers. Heath discloses a system and method for automatic version upgrading and maintenance that teaches/suggests to update game software components on gaming terminals using one or more update triggers (abstract, 1:34-3:38, and figs 1A-7C). Thus, it would have been obvious to an artisan at a time prior to the invention to apply the process of to update game software components on gaming terminals using one or more update triggers as taught/suggested by Heath to improve the server and gaming system of disclosed admitted prior art for the predictable result of automatically upgrading and maintaining software based on pre-arranged periodic or event driven basis.

***Response to Arguments***

16. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection. Although not a holding herein, Pease (5759102, 6135887) and Wells (6219836, 6488585 and 6805634) is equally relevant [as in evidence from action in parent 10659827] and may be applied to presently claimed invention at least for same reasons indicated above with respect to admitted prior art in so far as automatic or server control of updates, upgrades and maintenance is taught by each cited system.

***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Sager/  
Primary Examiner, Art Unit 3714